

REMARKS/ARGUMENTS

Favorable consideration of this application in light of the following discussion is respectfully requested.

Claims 1-4 are pending in the application.

In the outstanding Office Action, Claims 1-4 were rejected under 35 U.S.C. § 101 as claiming the same invention as that of Claims 1-19 of prior U.S. Patent No. 6,719,462; Claims 1-2 were rejected under 35 U.S.C. § 102(a) as being anticipated by Konishi (JP 05-131696, hereinafter Konishi) in view of Goto et al. (U.S. Patent No. 5,225,881, hereinafter Goto); and Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Konishi in view of Goto.

Applicants acknowledge with appreciation the telephone interview between the Examiner and Applicants' representative on April 12, 2005. As discussed during the telephone interview of April 12, 2005, a rejection under 35 U.S.C. § 101 requires the claims in the two documents to be identical. However, U.S. Patent No. 6,719,469 cited in the Official Action recites claims with different limitations. Therefore, Applicants submit the rejection of Claims 1-4 under 35 U.S.C. § 101 is improper as Applicants' pending claims and the allowed claims of U.S. Patent No. 6,719,469 are directed to different inventions. During the interview, the Examiner acknowledged that the rejection under 35 U.S.C. § 101 was improper and that a new Official Action would be prepared and mailed. However, to expedite progress toward an allowance, Applicants have filed a terminal disclaimer herewith regarding U.S. Patent No. 6,719,469.

Briefly recapitulating, Claim 1 is directed to an inkjet recording apparatus that includes a) a housing; b) an inkjet recording head arranged to eject ink drops onto front and back surfaces of a recording sheet; and c) a sheet feeding mechanism configured and adapted for feeding at least a portion of a recording sheet to a location outside of the housing to

expedite drying of the ink drops after the first side of the sheet has been printed, and for feeding the dried printed sheet back into the housing for printing on the second side of the sheet. As noted in Applicants' paragraph [0054], "the time period that the eject rollers 42 and 43 grip the sheet 3 at the trailing edge thereof is nearly equal to a time period in which the ink dries up." This allows for higher quality printing due to less smearing.

Konishi describes a printer configured for two sided printing and that includes a reversal guide 9 arranged in the body 1 and a single output (ejection rollers 12).¹ However, Konishi does not disclose or suggest "a sheet feeding mechanism configured and adapted ... for feeding the dried printed sheet back into the housing for printing on the second side of the sheet." In Konishi, the sheet is returned for second side printing without any delay,² let alone a delay to allow drying as recited in Applicants' claims. Konishi does describe a timer, however the timer is used to calculate when the end of the sheet is near the ejection rollers. Once the timer calculates the end of the sheet is approaching the ejection rollers, the path switching guide is switched and the paper is returned for second side printing. Thus, Konishi does not disclose or suggest "a sheet feeding mechanism configured and adapted ... for feeding the dried printed sheet back into the housing for printing on the second side of the sheet."

Applicants' Claim 2 recites, *inter alia*, "a sheet feeding mechanism located within said housing for feeding the recording sheet in a first direction at least partially outside said housing to expedite drying of the ink drops after one side of the sheet has been printed and before a second side of the sheet is printed, and in a second direction for feeding the dried one-side printed sheet back into the housing for printing on the second side of the sheet."

Applicants' Claim 3 recites, *inter alia*, "a second sheet ejection path, comprising a switchback mechanism configured and adapted for transporting at least a portion of a

¹ Konishi, Figure 1.

² Konishi, paragraph [0018]

recording sheet printed on the first surface to a location outside the housing to expedite drying of the print on the first surface and for returning the recording sheet printed on the first surface into the housing for printing on the recording sheet second surface.” Similar to Claim 1, Konishi does not disclose or suggest the above-mentioned features of Claims 2-3.

MPEP § 2131 notes that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.” *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in “at least one of two-digit, three-digit, or four-digit” representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02. “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Because Konishi does not disclose or suggest all the features recited in Claims 1-3, Konishi does not anticipate the invention recited in Claims 1-3, as well as Claim 4 which depends from Claim 3.

Applicants have also considered the Goto reference and submit Goto does not cure the deficiencies of Konishi. As none of the cited prior art, individually or in combination, disclose or suggest all the elements of Applicants’ independent claims, Applicants submit the

inventions defined by Applicants' independent claims, and all claims depending therefrom, are not rendered obvious by the asserted references for at least the reasons stated above.³

Accordingly, in light of the previous discussion, Applicants respectfully submit that the present application is in condition for allowance and respectfully request an early and favorable action to that effect.


Respectfully submitted,

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³ MPEP § 2131 "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

MPEP § 2142 "...the prior art reference (or references when combined) must teach or suggest **all** the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."